

**REMARKS****DRAWINGS**

The drawings are objected to because reference character 20 has been used to designate the "walkway pad" and the "adhesive tape," and characters "20" and "25" have both been used to designate an adhesive tape.

In response to these objections, the Applicants have enclosed herewith a corrected set of drawings for Figs 1 and 2. Namely, the arrow extending from numeral 25 in the upper left-hand corner of the drawing now extends into the tape.

**SPECIFICATION**

The Applicants have amended the specification to include the patent number of U.S. Serial No. 09/039,849, which was filed on March 16, 1998. They have also updated the status of U.S. Serial No. 330,041.

The Examiner has objected to the specification because the Examiner alleges that it does not provide support for the walkway pad being comprised of "asphaltic materials or concrete." Clarification has been requested.

The Applicants direct the Examiner's attention to page 8, lines 10-19, wherein the written description provides direct antecedent basis for the claimed subject matter:

[a]s noted hereinabove, the adhesive tape 25, of whatever composition, is pre-applied to the walkway pad 20 at the time of manufacture, so that the pad 20 is self-adhering upon removal of the release paper 32. The walkway pads can comprise a variety of materials including **asphaltic materials, concrete** and rubber-based materials, although the present invention is not necessarily limited to the selection of a particular walkway pad. Suitable rubber walkway pads are commercially available from Bridgestone/Firestone Inc., as their RubberGard Walkway Pads, which are formulated from reprocessed synthetic rubber, containing up to about 10 parts by weight of natural rubber. The rubber can contain fabric and non-metallic reinforcing cords. [emphasis added]

**REJECTIONS UNDER 35 U.S.C. § 102**

The Examiner has rejected claims 1-7 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,504,136 to Davis et al. According to the Examiner, Davis discloses a method for applying walkway pads including affixing a tape that includes a release paper, stripping the release paper, and applying force to the pad.

With respect to claims 2-4, the Examiner has found that Davis teaches that the walkway pad is formed from a rubber-based material, and that the adhesive is formed from a blend of EPDM and butyl rubbers. With respect to claim 5, the Examiner has found that Davis teaches applying the adhesive to the rear side of a walkway pad, which the Examiner believes inherently includes at least the opposed edges. With respect to claim 6, the Examiner has found that Davis teaches the step of preparing an area by use of a primer.

Reconsideration is respectfully requested. Despite the Examiner's sundry findings, it does not appear that the Examiner made any findings with respect to the limitation "affixing a 100% solids tape to one flat surface of a walkway pad prior to use in the field." Indeed, Davis does not teach this step.

One unique aspect of the present invention is the application of adhesive tape to the walkway pad prior to the walkway pad being delivered for use in the field.<sup>1</sup> In other words, the tape is applied at the factory as part of the manufacturing operation. As a result, adhesion between the tape and pad is maximized due to the clean and controlled conditions as opposed to those typically found in the field.<sup>2</sup> The prior art, such as taught by Davis, teaches only application of tape to the walkway pad in the field.

Claim 1 as amended emphasizes this distinction. Specifically, claim 1 now recites "said step of affixing occurs at the location that the pad is manufactured." That is, the tape is not applied in the field as taught by Davis.

Applicants have also added claim 8, which recites the step of "providing a walkway pad to a rooftop, where the walkway pad includes a solids tape applied to a substantially planar surface of the walkway pad." Obviously, providing a pad that carries a tape necessarily requires that the tape is pre-applied (*i.e.*, not applied in the field).

Newly added independent claim 13 likewise recites the step of "affixing a solids tape to a substantially planar surface of a plurality of walkway pads." Here again, the tape is applied to the walkway pad prior to use in the field. Newly

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<sup>1</sup>Written description page 4, lines 18-21.

<sup>2</sup>Written description page 6, lines 21 *et seq.*

Independent claims 25, 26, and 27 provide alternate ways of claiming Applicants invention.

### CONCLUSION

Applicants maintain that their invention is patentable over the cited prior art. Namely, the prior art does not teach, contemplate, or suggest applying the tape prior to delivery of the pads to the field. Newly added independent claims 8 and 13 emphasize this distinction. Accordingly, a formal Notice of Allowance of claims 1-4 and 6-27 is earnestly solicited. Should the Examiner care to discuss any of the foregoing in greater detail, the undersigned attorney would welcome a telephone call.

The Commissioner is specifically authorized to charge Deposit Account No. 06-0925 in the amount of \$348.00 for the payment of fees associated with this Response and Amendment. In the event that an additional fee is due or that any amount should be credited, the Commissioner is authorized to charge any additions fees or credit any overpayment to Deposit Account No. 06-0925.

Respectfully submitted,



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## MARKED-UP CLAIMS

1. (Amended) A method for applying walkway pads to roofing membranes [comprises], the method comprising:

3 affixing a [100 percent] solids tape to one flat surface of a walkway pad,  
4 [prior to use in the field, the opposite side of said tape carrying a protective  
5 layer of release paper] where the tape carries a protective layer of release  
6 paper, and where said step of affixing occurs at the location where the pad is  
7 manufactured;

8 stripping said release paper from said tape immediately prior to use;  
9 subsequently placing the exposed surface of said tape directly onto the  
10 upper surface of the roofing membrane; and,

11 applying force directly to said walkway pad to enhance the bond  
12 between said pad and the membrane created by said tape.

1 2. (Amended) [A] The method[, as set forth in] of claim 1, where said walkway  
2 [pads] pad [comprise] comprises asphaltic materials, concrete [and] or rubber-  
3 based materials.

1 3. (Amended) [A] The method[, as set forth in] of claim 1, wherein said  
2 [adhesive] solids tape comprises EPDM rubber, butyl rubber [and] or blends  
3 thereof.

1 4. (Amended) [A] The method[, as set forth in] of claim 1, wherein said  
2 walkway pads comprise rubber-based materials and said [adhesive] solids tape  
3 comprises a blend of EPDM and butyl rubbers.

1 6. (Amended) [A] The method[, as set forth in] of claim 1, further including the  
2 additional step of

3 preparing the area of the roofing membrane to which said walkway pad  
4 will be applied prior to said step of [stripping] removing.

1 7. (Amended) [A] The method[, as set forth in] of claim 6, wherein said step of  
2 preparing includes the step of priming the area of the roofing membrane to which  
3 said walkway pad will be applied prior to said step of [stripping] removing.



## MARKED-UP PARAGRAPHS

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703600 MAIL ROOM

Page 1, lines 4-6.

This application is a divisional of U.S. Patent Application Serial No. 09/039,849 filed on March 16, 1998, U.S. Patent No. 6,080,458, which is a continuation of U.S. Serial No. 08/606,119 filed on February 23, 1996, now abandoned.

Page 7, line 25-page 8, line 2.

Examples of suitable adhesive tape formulations are commercially available from Adco Products Inc., as their 510 or their 303 formulation. Another suitable adhesive tape formulation is commercially available from Ashland Chemical as their 408 formulation. These formulations are also described in U.S. Pat. Nos. 4,855,172, 5,242,727 and 5,234,987 the subject matter of which is incorporated herein by reference. Another EPDM tape composition is described in co-pending application U.S. [Ser. No. 08/330,041, commonly owned by the Assignee of record,] Pat. No. 5,504,136, the subject matter of which is also incorporated herein by reference.